

Harold J. Wanebo and Shashikant Mehta  
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Filed: April 7, 1999  
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*A. Comt*  
--19. (New) A method for treating cancer in a subject comprising administering to the subject an effective amount of paclitaxel and an effective amount of C6-ceramide, sequentially or concomitantly.

REMARKS

Claims 1-15 were pending and under examination in the subject application. Applicants have hereinabove added new claims 16-19. Support for new claims 16 and 17 may be found in the specification inter alia at page 2, lines 31-34 and page 11, lines 5-6 and 10-15. Support for new claim 18 may be found in the specification inter alia at page 13, lines 3-8 and page 11, lines 5-6 and 10-15. Support for new claim 19 may be found in the specification inter alia at page 11, lines 24-35. Applicants maintain that the amendments are fully supported by the specification and do not raise any issue of new matter. Accordingly, applicants respectfully request that the Examiner enter the Amendment. Upon entry of the Amendment, amended claims 1-115 and new claims 16-19 will be pending and under examination.

In the July 13, 2000 Election Requirement, the Examiner to whom the subject application is assigned required election of a single enhanced combination of one antitumor chemotherapeutic agent with one ceramide and to add a claim to the elected enhanced combination.

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Election Requirement

The Examiner stated that claims 1-15 are drawn to compositions and methods for treating cancerous tumors employing an enhanced combination of an antitumor chemotherapeutic agent and a ceramide. The Examiner required applicants to elect a single enhanced combination of one antitumor chemotherapeutic agent and one ceramide and to add a claim to the elected enhanced combination.

The Examiner stated that the several inventions above are independent and distinct, each from the other, as they have acquired a separate status in the art of treating cancerous tumors as a separate subject matter for inventive and require independent searches. The Examiner noted that a reference to one enhanced combination of drugs would not be a reference to another enhanced combination of drugs under 35 U.S.C. 103. The Examiner stated that the claims read on a multitude of enhanced combinations of drugs which would require many fields (sic) of searches that would be an undue burden on the Examiner.

In response to this election requirement, applicants hereby elects, with traverse, to prosecute the combination of C6-ceramide, as the ceramide, and paclitaxel, as the antitumor chemotherapeutic agent.

Applicants maintain that the allegedly independent and distinct combinations of antitumor chemotherapeutic agents and ceramides are all recited in dependent claims, which would be deemed free of prior art if their respective independent claim is deemed free

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of prior art. Accordingly, applicants respectfully submit that a search directed to the independent claims should uncover any art relating to the alleged independent and distinct combinations of antitumor chemotherapeutic agents and ceramides. Therefore, applicants respectfully submit that a search directed to the independent claims would be sufficient.

Applicants request that the Examiner consider independent claims 1 2, and 11 "generic". Claims 3-9 include all the limitations of generic claims 1 and 2 with respect to a antitumor chemotherapeutic agent and ceramide; new claim 16 includes all the limitations of generic claims 1 and new claim 17 includes all the limitations of generic claims 2. Claim 10 is generic with respect to pharmaceutical compositions comprising at least one antitumor chemotherapeutic agent and a ceramide; new claim 18 includes all the limitations of generic claim 10. Claims 12-15 include all the limitations of generic claim 11 with respect to a method of treating cancer in a subject comprising administering to the subject ... at least one antitumor chemotherapeutic agent and at least one ceramide; new claim 19 includes all the limitations of generic claim 11.

Applicants maintain that the pending claims define a single inventive concept. Applicants maintain that generic claims 1, 2, 10, and 11 recite allowable subject matter.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the election requirement to a combination of one antitumor chemotherapeutic agent and one ceramide and

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examine all of the pending claims, i.e. claims 1-15 and new claims 16-19, for all of the claimed combinations of antitumor chemotherapeutic agents and ceramides on the merits.

If a telephone conference would be of assistance in advancing the prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the enclosed \$192.00 for four independent claims in excess of the 4 independent claims for which a fee was previously paid, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

*Elizabeth M. Wieckowski*

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents Washington, D.C. 20231

*Elizabeth M. Wieckowski 8/14/00*  
John P. White Date  
Reg. No. 28,678  
Elizabeth M. Wieckowski  
Reg. No. 42,226

John P. White  
Registration No. 28,678  
Elizabeth M. Wieckowski  
Registration No. 42,226  
Attorneys for Applicants  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, New York 10036  
(212) 278-0400